**REMARKS**

Claims 1-6, 8-10, and 15-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Number 5,018,060 to Gelb et al (hereinafter "Gelb") in view of United States Patent Number 5,757,571 to Basham et al. (hereinafter "Basham"). Claims 7, 11, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and in further view of United States Patent Application Publication Number 2003/0204672 by Bergsten (hereinafter "Bergsten"). Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and in further view of Bergsten and "Active Storage for Large-Scale Data Mining and Multimedia" Proceedings of the 24th VLDB Conference, New York, USA, 1998 by Erik Riedel et al. (hereinafter "Riedel").

For the Examiner's convenience and reference, Applicants' remarks are presented in substantially the same order in which the corresponding issues were raised in the Office Action. Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references.

Claims 1, 3, 5, 7, 9, 14-16, and 18-20 are amended and claims 2 and 8 are canceled. The amendments are fully supported by the specification.

Response to rejections of claims under 35 U.S.C. § 103(a)

Claims 1-6, 8-10, and 15-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham. Claims 7, 11, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and in further view of Bergsten. Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and in further view of Bergsten and Riedel. Applicant respectfully traverses these rejections.

Claims 1, 3, 5, 7, 9, 14-16, and 18-20 are amended to specify that storage media is magnetic tape. The amendment is well supported by the specification. Page 9, Paragraph 30; Fig. 1, Ref. 112.

Claim 1 is further amended with the limitation of claim 2, "…wherein the storage instruction comprises an instruction to scale the magnetic tape storage medium to a predefined capacity for optimal data access performance…" Claim 1 as amended. Claims 7 and 15 are similarly amended. Therefore Applicants traverse the rejections of claims 2 and 8 as representative of independent claims 1, 7, and 15 as amended.

Claims 1, 7, and 15 are further amended to include the limitation "…receive a dataset from an application that does not support scaling…" Claim 1 as amended. See also claims 7 and 15. The amendment is well supported by the specification, which teaches modifying the storage criteria of an application without changing the programming of the application. Page 13, Paragraph 43.

Thus the present invention as amended claims:

"a reception module configured to receive a dataset from an application that does not support scaling for storage on a magnetic tape storage medium;

an identification module configured to identify storage characteristics of the dataset; and

a scaling module configured to select a storage instruction in response to storage criteria applied to the storage characteristics, wherein the storage instruction comprises an instruction to scale the magnetic tape storage medium to a predefined capacity for optimal data access performance."

The present invention claims a dataset directed to storage on a magnetic tape storage medium. In contrast, Gelb teaches defining data classes, storage classes, management classes, and storage groups, with storage requests are matched with data, storage, and management classes and assigned a storage group. Gelb, Abstract. Data storage to storage devices is allocated based on a class and group. Gelb, Abstract. Thus Gelb teaches selecting data storage while the present invention claims a dataset directed to magnetic tape data storage.

In addition, the present invention claims receiving the dataset from an application that does not support scaling. In contrast, neither Gelb, Basham, nor Bergsten teach receiving a dataset from an application that does not support scaling.

The present invention further claims **selecting** a storage instruction comprising a scaling instruction to "scale the magnetic tape storage medium to a predefined capacity for optimal data access performance." In contrast, Gelb does not teach scaling or selecting scaling storage instructions. Basham does not teach **selecting** scaling to support data access performance. Basham does teach scaling for rapid access. Basham, Col. 14, Line 1 – Col. 15, Line 39, Fig. 8.

However, Basham does not teach **selecting** scaling. Instead by implication the applications of Basham storing data to the magnetic tape must specify the scaling employed. Bergsten also does not teach selecting scaling.

As discussed above, neither Gelb, Basham, nor Bergsten collectively teach all of the elements of the claims 1, 7, and 15. Applicants therefore assert that claims 1, 7, and 15 are allowable.

Applicants further assert that the teaching or suggestion to combine the allocating storage based on classes and groups of Gelb and the scaling of Basham can only be found in the Applicant's disclosure. There is no suggestion in Gelb directed to scaling. Basham contains no teaching directed to selecting storage instructions. It is "impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." *Uniroyal v. Rudkin-Wiley*, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) (citing *W. L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 312). Therefore, Applicants assert that claims 1, 7, and 15 are allowable.


As a result of the presented remarks, Applicants assert that independent claims 1, 7, and 15 are in condition for prompt allowance. Applicants have not specifically traversed the rejections of dependent claims 3-6, 9-14, and 16-20 under 35 U.S.C. § 103(a), but believe those claims to be allowable for depending from allowable claims. See, *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Should additional information be required regarding the traversal of the rejections of the dependent claims enumerated above, Examiner is respectfully asked to notify Applicants of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,

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